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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,951	11/08/2006	Franz jun. Neuhofer	NEUHOFFER, JR.-16 PCT	3739
25889	7590	10/24/2008		
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER TRIGGS, ANDREW J	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 10/24/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/590,951

**Applicant(s)**

NEUHOFFER, FRANZ JUN.

**Examiner**

Andrew J. Triggs

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanchfield, US Patent # 6,860,074.

Regarding claim 9, Stanchfield teaches a covering device for joints in panels such as floor panels (Abstract). Stanchfield teaches that the cover can be made of plastic based products, such as PVC (Column 4, Lines 50-51). These types of materials are commonly formed by extruding them through a machine to create the desired profile. Stanchfield teaches, in Figure 2, a clamping web (16) that protrudes downward from the covering flange (12) and extends in a longitudinal direction along the cover. The clamping web (16) is used to secure the cover by inserting it into the clamp (26). Stanchfield also teaches a compensating strip (40) on the underside of the covering flange that engages the covering flange with a tongue and groove mechanism (18). Stanchfield also teaches, in Figure 2, that the floor covering (12) is flat over the floor (24 and 25) of which it covers. Stanchfield teaches, in Figure 2, that the tongue (18) is on the covering device and the groove (42) is on the compensating strip (40) as seen in Figure 3. Stanchfield discloses the claimed inventions except for the tongue and groove mechanisms

are reversed. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make the cover with the groove and the compensating strip with the lug, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

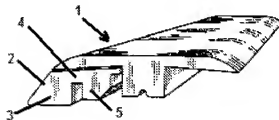
Regarding claim 7, Stanchfield teaches the device as described in claim 1. Furthermore,

Stanchfield teaches, in Figure 19, that the various components of the covering device (300) are formed together and then broken to separate them (Column 8, Lines 33-40). The pieces can be separated by scoring and snapping, cutting, sawing or simply bending. This lets the product be manufactured as whole units as well as letting the installer buy all the pieces needed to complete the job. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

Regarding claim 8, Stanchfield teaches all the components can be formed at the same time and include "break away" sections or "connecting lands" where the pieces are separated (Column 8, Lines 33-35). Since the covering device is made from a plastic material and plastic materials are commonly extruded, it would be obvious that the cover and compensation strip would be formed, as well as coated at the same time. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

3. Claims 2-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanchfield, US Patent # 6,860,074 in view of Neuhofer, US Design Patent # D542,941.

Regarding claim 2, Stanchfield teaches a covering device with a compensating strip that has a tongue and groove connecting mechanism but does not teach the compensating strip has two legs. However, Neuhofer teaches in the annotated figure below, a covering device (1) with a compensating strip (2) that has a basic form of an angle and two legs (3 and 4). In combination with Stanchfield, leg (4) would have the tongue and groove mechanism on it. Furthermore, it can be seen that the compensating strip (2) makes an extension of the cover (1) extending downward. One of ordinary skill in the art at the time of the invention would have been motivated to have a compensating strip with two legs because the legs form a continuation of the covering device that creates a smooth even flowing cover over a gap between panels. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.



Regarding claim 3, Stanchfield teaches a compensating strip but does not teach a supporting leg connected to the leg that has the tongue and groove mechanism. However, Neuhofer teaches in the annotated figure above, that the

compensating strip (2) has a supporting leg (5) projecting from leg (4). In combination with Stanchfield, leg (4) would have the tongue and groove mechanism on it. One of ordinary skill in the art at the time of the invention would have been motivated to further include a supporting leg because a groove between the supporting leg and other leg can be used to secure the compensating strip securely. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

Regarding claim 5, Stanchfield teaches a cover with a compensating strip that fit together in a tongue and groove fashion but only with one tongue and one groove. However, Stanchfield also shows further embodiments of the compensating strip that has different shape tongues. Figure 18 shows a compensating strip (210) that has a tongue (218) that inserts into groove (219) that is located on the clamping web (16). This embodiment is similar to the one shown in Figure 8 of the applicant to represent the peripheral projection. Stanchfield only teaches on tongue and groove mechanism however it would have been obvious to one of ordinary skill in the art at the time of the invention to use multiple securing mechanisms because they would further lock and locate the compensating strip to the covering device. Also, Stanchfield discloses the claimed inventions except for the tongue and groove mechanisms are reversed. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make the cover with the groove and the compensating strip with the lug, since it has been held that a mere reversal of the essential

working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

Regarding claim 6, Stanchfield teaches, in Figure 6, that where the compensating strip (40) connects to the covering flange (12) there is an adhesive strip (31).

Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stanchfield, US Patent # 6,860,074 in view of Neuhofer, US Design Patent # D542,941 in further view of Kemper, US Patent # 6,345,480.

Regarding claim 4, Stanchfield in view of Neuhofer teach a cover device that has a supporting leg on the compensating strip. It can be seen in Figure 1 of Neuhofer that there is a channel between the legs that is capable of accepting a fixture from the profile cover but Stanchfield only teaches one securing means (26) on the fixture. However, Kemper teaches the use of two securing means (6 and 12) on the fixture (3). One of ordinary skill in the art at the time of the invention would have been motivated to include two or more securing means on the floor mounting plate fixture in order to secure not only the covering device but also the compensating strip to the floor. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

***Response to Arguments***

5. Applicant's arguments filed 10 September 2008 have been fully considered but they are not persuasive regarding the traversal of the reversal of parts rejection. Examiner feels that Stanchfield satisfies all the limitations of the application at hand. Furthermore, Stanchfield shows in Figure 2, that one side of the cover does not have the tongue and groove mechanism and can be placed on a flat floor surface. The other side of the cover works in conjunction with the compensating strip where the tongue on the cover and groove on the strip engage each other. This concept is identical to applicant's figures 1 and 4 where one side of the cover rests on the floor and the other side of the cover engages the compensation strip.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Triggs whose telephone number is 571-270-3657. The examiner can normally be reached on Monday through Thursday 7:00am - 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./  
Supervisory Patent Examiner, Art Unit 3635

/Andrew J Triggs/  
Examiner, Art Unit 3635